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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/694,304
Filing Date: October 27, 2003
Appellant(s): ALLEN, DAVID M.

Douglas L Wathen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07 November 2008
appealing from the Office action mailed 22 July 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claim 12 is rejected under 35 USC §103(a) under Trutwin (U.S. Patent No. 6,202,380) in view of Baum (U.S. Patent No. 1,585,960) as applied to claim 1 above and further in view of Pinto (U.S. Patent No. 6,189,276).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,202,380	TRUTWIN	3-2001
1,585,960	BAUM	9-1925
6,189,276	PINTO	2-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11, 13, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trutwin (U.S. Patent No. 6,202,380) in view of Baum (U.S. Patent No. 1,585,960).

Claim 1: Trutwin discloses a baseboard that is installed (Col. 5, lines 35-45) in a region where a lower edge of a wall meets a floor comprising a base portion (Fig. 2: 17) having a back (21) and opposed front surfaces (20), lower (19) and upper ends (26) the back of the base is against the wall and the lower end adjacent the floor and a top portion (11) having back (15) and front surfaces (14), lower (13) and upper (12) ends, the back surface of the top portion is adjacent the wall and the base and top portions have dissimilar cross sections when taken perpendicular to the respective back surfaces. While Trutwin discloses that the juncture between the top and bottom portions have a general direction from the higher point to a lower point from the front to back surfaces (e.g. from portion 26 to portion 25), it does not disclose that the juncture is a slope from the front surface to the back surface. Baum discloses a baseboard (Fig. 2) that has a juncture (6) that slopes from the front surface to the back surface. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of functional equivalence to have the juncture in Trutwin slope as in Baum because Trutwin discloses

that the invention is not limited to the details of construction and arrangement of components and is capable of other embodiments (Col. 2, lines 40-45) and the slope junction would perform equally as well as the junction disclosed in Trutwin.

Claim 2: the base and top portions extend along the wall adjacent the floor.

Claim 3: while the prior art of record does not disclose that the base and top portions have the same length in the elongated direction, it would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have this limitation because it is well known in the art that structures such as these are manufactured the same length for ease of stocking and transport, so one of ordinary skill in the art would not make the base and top portions of different lengths.

Claim 4: while the prior art discloses a generally rectangular horizontal cross section, it does not particularly disclose installing the member where one wall meets an adjacent wall. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to install the member in this manner because it is well known in the art to use trim at wall intersections.

Claim 5: Trutwin in view of Baum discloses the sloped surface is the same (Baum Fig. 2).

Claims 6-8: Trutwin in view of Baum discloses the claimed invention except for the angles of the slope. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these angles because the prior art of record notes that the invention may be altered and remain within the scope of the invention (Trutwin: Col. 2, lines 40-45; Baum: lines 77-82), and to have the angles as claimed would not depart from the scope of the invention.

Claim 9: the prior art of record discloses the claimed invention except for the thicknesses of the top and bottom portions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the thicknesses the same as a matter of design choice because Trutwin discloses that while the bottom is thicker than the top (Col. 5, lines 45-50) the invention is not limited to the details of construction and arrangement of components and is capable of other embodiments (Col. 2, lines 40-45) and one can make the top and bottom portions the same thickness if one desired for aesthetic purposes.

Claim 10: Trutwin discloses (as noted in the drawings) that the material is wood, but it does not disclose that the baseboard is made from a single piece of wood so that the grain would match. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use a single piece of wood in order to preserve timber and also for aesthetic purposes.

Claim 11: the base portion has a recess (Trutwin: formed by 25, 29, 33) where the back surface meets the upper end.

Claim 13: the prior art of record discloses the claimed invention except for the method of forming the baseboard. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the baseboard by providing a board with a front and back surface and cutting the board lengthwise at a non-perpendicular angle to form the top and bottom surfaces because Trutwin in view of Baum can be made in such a manner (Trutwin: Col. 2, lines 40-45) and one of ordinary skill in the art would form the baseboard as claimed.

Claim 16: Trutwin discloses a baseboard assembly installed in a junction of a wall and a floor (Col. 5, lines 35-45) that has a base portion (17) having back and front surfaces (21, 20, respectively), lower and upper ends (19, 26 respectively), the base portion has the back against the wall and lower end

adjacent the floor, the lower end of the base portion is flat and perpendicular to the back surface, a top portion (11) having back and front surfaces (15, 14 respectively) lower and upper ends (13, 11 respectively), the back surface is adjacent the wall. While Trutwin discloses that the juncture between the top and bottom portions have a general direction from the higher point to a lower point from the front to back surfaces (e.g. from portion 26 to portion 25), it does not disclose that the juncture is a slope from the front surface to the back surface. Baum discloses a baseboard (Fig. 2) that has a juncture (6) that slopes from the front surface to the back surface. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of functional equivalence to have the juncture in Trutwin slope as in Baum because Trutwin discloses that the invention is not limited to the details of construction and arrangement of components and is capable of other embodiments (Col. 2, lines 40-45) and the slope junction would perform equally as well as the junction disclosed in Trutwin.

Claim 17: Trutwin discloses a baseboard assembly installed where a wall meets a floor (Col. 5, lines 35-45) having a base portion (17) having back and front surfaces (21, 20, respectively), lower and upper ends (19, 26 respectively), the

base portion is installed in the junction with the back surface against the wall and lower end adjacent the floor, the lower end of the base portion is flat and perpendicular to the back surface, and a top portion (11) having back and front surfaces (15, 14 respectively), lower and upper ends (13, 12 respectively) the back surface is adjacent the wall. While Trutwin discloses that the juncture between the top and bottom portions have a general direction from the higher point to a lower point from the front to back surfaces (e.g. from portion 26 to portion 25), it does not disclose that the juncture is a slope from the front surface to the back surface. Baum discloses a baseboard (Fig. 2) that has a juncture (6) that slopes from the front surface to the back surface. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of functional equivalence to have the juncture in Trutwin slope as in Baum because Trutwin discloses that the invention is not limited to the details of construction and arrangement of components and is capable of other embodiments (Col. 2, lines 40-45) and the slope junction would perform equally as well as the junction disclosed in Trutwin.

Claim 18: Trutwin in view of Baum discloses providing the baseboard assembly as claimed, the base is installed where the

back is against the wall and lower end adjacent the floor (Trutwin: Col. 5, lines 35-45), and installing the top portion (11) above the base portion with the back surface against the wall and the lower end engages the upper end of the base.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trutwin in view of Baum as applied to claim 1 above, and further in view of Pinto (U.S. Patent No. 6,189,276).

Claim 12: the prior art of record discloses the claimed invention except where the top portion has a recess (proximate 18) formed where the back surface meets the lower end. Pinto discloses a baseboard with a top and bottom portion (Fig. 6) and a recess in the top portion. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to place a cavity in the top portion of the board in Trutwin in view of Baum in order to allow for the installation of cables and Trutwin notes that other embodiments are available (Col. 2, lines 4-45), and this limitation would be within the ordinary level of skill in the art without departing from the scope of the prior art of record.

(10) Response to Argument

The issue is whether it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the prior art of Trutwin in view of Baum regarding claims 1-11, 13 and 16-18, and further in view of Pinto with respect to claim 12. The examiner maintains that this combination would be obvious to one of ordinary skill in the art for the reasons set forth in the rejections noted above. Trutwin clearly states, "the invention is not limited in its application to the details of construction and to the arrangements of the components set forth in the following description...[t]he invention is capable of other embodiments and of being practiced and carried out in various ways." See column 2, lines 40-45.

Applicant first argues that the Trutwin reference solves a different problem than the present invention, namely that Trutwin defines an electrical passage in a baseboard and the present invention contemplates painting related benefits. While this may be true, the applicant has not provided in the claims any limitation drawn to painting in conjunction with the invention. Both Trutwin and the present invention disclose a two-piece trim material where a lower portion (e.g., Trutwin 17 and present invention 86 of figure 8) is attached to a wall, and

an upper portion (Trutwin 11 and present invention 90) is placed on top of the bottom portion. Regardless of the motivation of the invention, Trutwin and the present invention are substantially similar structurally with the exception of the juncture (present invention 84). The examiner, as a result, incorporated Baum to show a two-piece trim assembly with a juncture (Baum: 6) that would be functionally the same as the juncture in Trutwin while being structurally the same as the present invention. It is the examiner's position that these junctures are functionally equivalent.

Applicant next argues that the combination of the prior art of record incorporates improper hindsight. The examiner respectfully disagrees. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner maintains the position that the combination does not

incorporate improper hindsight and relies only on the level of ordinary skill in the art. As shown, the type of juncture that applicant is claiming is known in the art for a two-piece trim assembly (see Baum, Fig. 2: proximate 6). This type of juncture was not taken solely from applicant's disclosure because Baum clearly teaches this type of connection is known in the art at the time the invention was made.

In addition, applicant further argues that the combination of Trutwin and Baum does not yield a predictable result, citing *KSR International Co. V. Teleflex Inc.*, 82 USPQ 2d 1385, 1395 (citing *United States v. Adams*, 383 US 39, 50-51 (1966), which states, "When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." The examiner respectfully disagrees with applicant's position. The result of the combination does yield a predictable result in that the end product is a two-piece trim member assembled as noted above. The examiner argues that the shape of the juncture of both Trutwin and Baum result in an upper portion that is properly stabilized when placed on the lower portion. Both junctures in Baum and Trutwin are shaped to have a relative higher front surface (e.g., Baum: proximate 7) transition to a relatively

lower rear surface (e.g., Baum: proximate 5). Applicant's argument that it would be logical to "cut off the bottom of the lower portion of Trutwin" is respectfully unfounded as the issue of the argument is whether the juncture between the members in Trutwin and Baum are functionally equivalent.

Applicant also states that the combination is not a "mere substitution". Applicant further states that to qualify as a mere substitution, "The element being substituted would necessarily have to be used in the same way as in the original reference, keeping in mind its function and context" (*Brief of the Appellant*, page 5, lines 1-3.) The examiner argues that this is the very provision in the prior art of record. By observing both Trutwin and Baum, the juncture between the upper and lower portions of the trim function in the same way: to provide a connection between the upper and lower portions that would hold the upper portion in place with respect to the lower portion. As a result, the examiner asserts that this is a mere substitution.

Last, the examiner respectfully disagrees with applicant's assertion of what is assumed to be "boiler plate" language that is cited by the examiner from Trutwin (Col. 2, lines 40-45): that the prior art is capable of other embodiments. While language similar to this is common in many

patents, the examiner cited this to show that the features that were used by the examiner in rejecting the claims of the present invention were not critical features of the prior art, and that if the prior art states that other embodiments are available, then it would be reasonable to make functionally equivalent substitutions for the juncture.

Applicant's arguments with respect to claim 12 are the same as those provided in claim 1, above, so the arguments will not be repeated.

In closing, the examiner maintains that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine Trutwin in view of Baum for the reasons stated above, and the examiner respectfully maintains that the rejections made citing the prior art of record are proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William V Gilbert/

Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./

Supervisory Patent Examiner, Art Unit 3635

Conferees:

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